

Application Serial No.: 10/728,217  
Filing Date: December 4, 2003  
Docket: 2881 (203-5318)  
Page 4 of 6

Response to 6/1/07 Office Action

**RECEIVED**  
**CENTRAL FAX CENTER**

**AUG 09 2007**

**REMARKS**

The present application was filed on December 4, 2003 with claims 1-26. Claims 9-26 have been cancelled herein, so claims 1-8 remain pending in the application. Applicant reserves the right to pursue the cancelled claims in a divisional application.

In the Office Action of June 1, 2007, the Examiner has maintained the rejection of claims 1 and 3-8 on the grounds of nonstatutory obviousness-type double patenting as unpatentable over claims 1-12 of U.S. Patent No. 6,878,757 to Roby (hereinafter Roby '757'). Applicant will file a suitable terminal disclaimer upon indication that the claims are otherwise allowable in this application.

The Examiner has maintained the rejection of claims 1-8 under 35 U.S.C. §103 (a) as obvious over U.S. Patent No. 5,716,376 to Roby (hereinafter "Roby '376") in view of U.S. Patent No. 4,201,216 to Mattei ("Mattei"). However, nowhere does Roby '376 disclose or suggest a coating for a surgical article comprising: a) a copolymer having a predominant amount of epsilon-caprolactone and a minor amount of at least one other bioabsorbable copolymerizable monomer; and b) an effective antimicrobial amount of a metal salt of a fatty acid selected from the group consisting of fatty acid salts of lithium, rubidium, cesium, francium, beryllium, magnesium, strontium, barium, radium, aluminum, tin, lead, bismuth, transition metal, and mixtures thereof as recited in claim 1.

Mattei fails to remedy the deficiencies of Roby '376. Nowhere does Mattei disclose or suggest a coating for a surgical article comprising: a) a copolymer having a predominant amount of epsilon-caprolactone and a minor amount of at least one other bioabsorbable copolymerizable monomer; and b) an effective antimicrobial amount of a metal salt of a fatty acid selected from

Application Serial No.: 10/728,217  
Filing Date: December 4, 2003  
Docket: 2881 (203-5318)  
Page 5 of 6

Response to 6/1/07 Office Action

the group consisting of fatty acid salts of lithium, rubidium, cesium, francium, beryllium, magnesium, strontium, barium, radium, aluminum, tin, lead, bismuth, transition metal and mixtures thereof as recited in claim 1. Mattei's copolymer is preferably lactide and glycolide; nowhere in Mattei is there any mention or suggestion of epsilon-caprolactone. Moreover, as acknowledged by the Examiner, Mattei prefers calcium stearate; calcium salts are not recited in claim 1.

The Examiner's quote from applicants' specification regarding the use of calcium stearate in a coating notes that it would require an *impractical and uneconomical* dip coating process. Thus, contrary to the Examiner's assertions, the specification herein notes deficiencies in the use of calcium stearate, which would thus not suggest the use of the claimed salts.

As neither of the cited references provide all of the recited limitations, the Examiner has failed to establish a prima facie case of obviousness. To combine the references as suggested by the Examiner requires impermissible hindsight, i.e., applicant's own disclosure, to provide the impetus to combine the references. Thus, contrary to the Examiner's assertions, there is no motivation or suggestion to combine the references as suggested by the Examiner, nor is there any reasonable expectation of success.

Thus, it is respectfully submitted that neither Roby '376 nor Mattei, taken alone or in any combination, render claim 1 obvious, nor claims 2-8 which depend, directly or indirectly, therefrom.

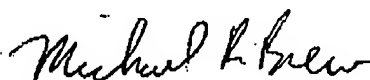
Therefore, for at least the foregoing reasons, neither Roby '376 nor Mattei render obvious claims 1-8 of the instant application and reconsideration of this rejection is respectfully requested.

Application Serial No.: 10/728,217  
Filing Date: December 4, 2003  
Docket: 2881 (203-5318)  
Page 6 of 6

**Response to 6/1/07 Office Action**

It is believed that the claims of the application, i.e., claims 1-8, are patentably distinct over the art of record and are in condition for allowance. In the event that the Examiner believes that a telephone conference or a personal interview may facilitate resolution of any remaining matters, the undersigned may be contacted at the number indicated below. Entry of the foregoing amendment and remarks, and early and favorable reconsideration of this application is respectfully requested.

Respectfully submitted,



Michael R. Brew  
Registration No. 43,513  
Attorney for Applicants

**Carter, DeLuca, Farrell & Schmidt, LLP**  
445 Broad Hollow Road, Suite 225  
Melville, New York 11747  
Tel.: (631) 501-5700  
Fax: (631) 501-3526  
MRB/nr